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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Jonathan BUCKLEY et al.) Group Art Unit: 2635
Application No.: 09/270,461) Examiner: Matsuichiro SHIMIZU
Filed: March 15, 1999)
For: ELECTROMECHANICAL SAFETY) Confirmation No.: 2532
SYSTEM FOR A FIREARM)

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

This reply brief is filed under 37 C.F.R. § 41.41(a) in reply to the Examiner's Answer mailed October 31, 2005.

The 35 U.S.C. § 135(b) Rejection

The Examiner's Answer has narrowed the rejection under 35 U.S.C. § 135(b) to three issues:

(1) whether appellants' copied claim limitation requiring a "notch" in the trigger (claim 26) is materially different than appellants' earlier claim limitation requiring an "aperture" in the trigger;

(2) whether appellants' copied claim limitation requiring "a plurality of display elements" (claims 25-29) is a material limitation; and

(3) whether appellants copied claim limitations requiring "at least the greater portion of the locking mechanism is located in front of a trigger guard" (claim 27) and "a finger-print scanner" (claim 29) were claimed in appellants' earlier claims.

Importantly, only the second issue applies to all the pending claims. Thus, if the Board reverses on this issue, independent claim 25 should be allowed and an interference with U.S. Patent 6,293,039 should be declared.

The essential dispute in this appeal centers on the Examiner's position with respect to the "materiality" of copied claim limitations that do not appear verbatim in the appellants' earlier claims. The Examiner takes the position that appellants cannot copy claim limitations unless "the same" limitations appear in appellants' earlier claims (i.e., claims that were pending before the one year issue date of the '039 patent). That analysis, however, ignores the words of the statute, which requires an earlier claim for "the same or substantially the same subject matter" as the copied claim. 35 U.S.C. § 135(b). The Examiner has never explained why appellants' earlier claims are not "substantially the same subject matter" as the copied claims.

In addition, the case law establishes that the appellants need only show that their copied claims do not differ from their earlier claims in any "material limitation." *In re Berger*, 279 F.3d 975, 982 (Fed. Cir. 2002). The case that *Berger* cites for this rule, *Corbett v. Chisolm*, 568 F.2d 759 (CCPA 1997), explains that a "material limitation" is a limitation that is "necessary to patentability." *Id.* at 765-66. Here, the Examiner has failed to rebut appellants' showing that their copied claims do not differ from their earlier claims in any "material limitation." The Examiner's Answer does not substantively address "materiality." Reading between the lines, it appears the Examiner takes the position that any difference between the copied claims and appellants' earlier claims is "material." But that approach ignores the words "substantially the same" in the statute and eliminates "materiality" from the analysis.

1. The claim element requiring a “notch” in the trigger does differ materially from the earlier claimed “aperture” in the trigger.

Copied claim 26 (claim 2 of the ‘039 patent) requires a notch in the trigger.

Appellants earlier claim 5 required “at least one aperture” in the trigger. The Examiner contends the two limitations “are not the same” because a “notch” provides restraining in one dimension and an “aperture” provides restraining in two dimensions.

The Examiner, however, has not explained why a notch and an aperture are not “substantially the same” for purposes of this invention. Both function as a site for the locking pin to engage the trigger. And since the trigger moves in only one dimension, it makes no difference whether the engagement site is a notch or an aperture. Indeed, the applicants’ specification uses the words interchangeably to describe reference numerals 56a and 56b. See original specification at 12.

Moreover, there is nothing in the specification or prosecution history of the ‘039 patent to suggest that the “notch” is a material limitation. Indeed, because the limitation appears only in a dependent claim, it is self-evident that the limitation was not “necessary to patentability.”

2. The claim element requiring “a plurality of display elements” is not a material limitation.

The Examiner’s rejection on this ground is the only outstanding rejection under 35 U.S.C § 135(b) that applies to the copied independent claim, claim 25. Accordingly, if the Examiner’s rejection is reversed, claim 25 should be allowed and an interference with U.S. Patent 6,293,039 should be declared.

Appellants acknowledge that their earlier claims did not include a claim element corresponding to the element in claim 25 requiring “a plurality of display elements

configured to display an operating status of the locking mechanism.” Although appellants’ drawings show such display elements, no such element was included in the claims because display elements are old in the art and have nothing to do with novelty and nonobviousness of the invention claimed in appellants’ earlier claims or in the ‘039 patent. In other words, the claim element is not necessary to patentability and is not material to the claimed invention.

In the Examiner’s Answer, the Examiner acknowledges that “this limitation appeared in the claims of the ‘039 patent when the application was filed, and it was never argued to be a basis for patentability.” The Examiner also appears to admit that the display element was “known” in the prior art. But the Examiner argues that “the fact that the ‘plurality of display elements’ are claimed in conjunction with the locking mechanism in the patent in order to show the status of the locking mechanism is material to the claimed invention.” Although the Examiner’s reasoning is not entirely clear, it appears he is arguing that the limitation is material simply because it is recited in the claims. Such reasoning simply eliminates materiality from the analysis.

The case law, however, makes clear that “materiality” of a missing limitation is essential to a § 135(b) rejection. For example, in the Federal Circuit’s recent decision in *In re Berger*, the Court’s analysis of a § 135(b) rejection included an analysis of the materiality of a missing limitation. In conducting that analysis, the Court reviewed the prosecution history of the issued patent and, after finding that the missing limitation was added in an amendment to overcome the prior art, concluded the missing limitation was material. The *Berger* opinion did not define “materiality,” but it cited and is consistent

with an earlier CCPA decision by Judge Rich, *Corbett v. Chisolm*, which defined “materiality” in the 135(b) context as “necessary to patentability.”

An example of a case applying this standard and finding that a missing limitation was not material and, therefore, not a basis for a § 135(b) rejection is *Riesser v. Williams*, 255 F.2d 419 (CCPA 1958). The Board has recently relied on this case as “defining the ‘same or substantially the same subject matter’ test under § 135(b) as whether ‘the essential patentable subject matter is the same’ in both the issued patent claim and the application claim that is the subject of the § 135(b) inquiry.” See *Berman v. Housey*, 291 F.3d 1345, 1349 (Fed. Cir. 2002). In *Riesser*, an interference count included multiple limitations that did not appear in the application claim that was the subject of the § 135(b) inquiry. The Court found that these limitations “were of no patentable significance” and, therefore, did not preclude the applicant from copying the claims of an issued patent that corresponded to the count. In reaching this decision, the Court offered the following explanation:

The rule that every limitation of an interference count must be considered material, which rule is applied in determining the right to make the count and priority of invention, is not controlling on the question of estoppel under 35 U.S.C. 135. In the latter situation, the question as to the materiality of limitations is to be considered on its merits, and limitations found to be immaterial may be disregarded.

255 F.2d at 422.

Here, the Examiner has misapplied these guidelines, in effect adopting a rule that every limitation must be considered material instead of considering the materiality of the missing limitation on its merits. And when the materiality of the claim element requiring “a plurality of display elements” is considered on its merits, the prosecution histories of

both the '039 patent and the pending application demonstrate that this limitation is not "necessary to patentability."

The prosecution history of the '039 patent demonstrates that the "display elements" limitation was of "no patentable significance." The "display elements" limitation appeared in the claims as filed, and in rejecting those claims, the Examiner cited prior art showing an electronic display in a firearm that indicated when the firearm was locked and when the battery was low (U.S. Patent No. 5,448,847). In response, the applicant for the '039 patent never argued that the display elements, or the display elements in combination with other claim elements, were a basis for patentability. Instead, it argued that the distinction over the prior art lay in the geared motor with a threaded spindle and nut connection. It was on the basis of this argument that the Examiner found that the claims of the '039 patent were patentable.

Similarly, the prosecution history of the pending application demonstrates that the "display elements" limitation is of "no patentable significance." Applicants disclosed display elements in their specification but did not include this limitation in their claims. These claims were initially rejected, and on January 21, 2003, applicants conducted an interview with the Examiner and his Supervisory Examiner. The claims discussed at that interview included three elements: a blocking assembly (including a gear train and a motor for driving the gear train), a power source, and a power control unit. See January 8, 2003 facsimile to Examiner Shimizu. The claims discussed did not include a limitation directed to "display elements." During the interview, the Examiners suggested some minor amendments to the "blocking assembly" limitation. With those amendments, the Examiners concluded that the applicants claims "would appear to

overcome art of record.” See Interview Summary. In other words, the Examiners concluded that claims directed to the blocking assembly, and without any mention of display elements, were patentable. Thereafter, as noted in the Interview Summary, the Examiners of record thereafter consulted with an Examiner in the firearm art, which led to the discovery and citation of the ‘039 patent for the first time and to the rejection of the claims that had been deemed patentable at the January 21, 2003 interview.

From the foregoing, it is clear that the “display elements” limitation is “not necessary to patentability” and is “immaterial” for purposes of 35 U.S.C. § 135(b). The Examiner has cited no evidence to the contrary, and there is none. The “essential patentable subject matter is the same” in both the copied claims from the ‘039 patent and the claims that were pending in the pending application within the one year time bar provided in 35 U.S.C. § 135(b). It follows that the applicants should be permitted to copy this limitation or that it should be “disregarded” in deciding whether to declare an interference between the pending application and the ‘039 patent.

3. The claim elements requiring “at least the greater portion of the locking mechanism . . . located in front of a trigger guard” and “a finger-print scanner” do not differ materially from earlier limitations.

The third issue challenged by the Examiner can be divided into two sub-issues. First, did appellants’ earlier claims include a claim element for “at least the greater portion of the locking mechanism . . . located in front of a trigger guard” or for substantially the same subject matter. Second, did appellants’ earlier claims include a claim element for “a finger-print scanner” or for substantially the same subject matter.

As a preliminary matter, neither of these limitations is “material” because neither is “necessary to patentability.” Both limitations appear only in dependent claims that

appellants have copied and, hence, could not be necessary to patentability. The Examiner's Answer does not address this issue.

The reasons given by the Examiner for rejecting appellants' copied claims that recite these limitations are also flawed.

Copied claim 27 (claim 3 of the '039 patent) requires that "at least the greater portion of the locking mechanism is located in front of a trigger guard and below the barrel of the gun." Appellants' earlier claim 1 required a "locking apparatus" including a "blocking means," a "power supply means," and a "power control means." The "greater portion" of the collective structures described in appellants' specification corresponding to these means are "located in front of a trigger guard."

The Examiner contends that "means plus function does not encompass location." But no authority is cited for this proposition. Moreover, the proposition makes no sense in this case because the location of the blocking means relative to the trigger (and hence the trigger guard) is important to the operation of the locking mechanism. The examiner also takes the position that "the greater portion of the blocking means (elements 38, 40, 42, 44, 60, 54) is not in front of the trigger guard." Here, the Examiner apparently misapprehends the portion of the gun that qualifies as the "trigger guard," which is the internal edge of the structure surrounding the opening that houses the trigger. Elements 38, 40, 42, and most of 44 are located in front of the trigger guard. Indeed, these elements are in precisely the same location relative to the trigger guard as the corresponding elements shown in the drawings of the '039 patent. Assuming the drawings of the '039 patent support this claim limitation, then the drawings in appellants' specification support this limitation as well.

Copied claim 29 (claim 5 of the '039 patent) requires an "identification unit" that comprises "a finger-print scanner." Appellants earlier claim 1 required a "power control means for controlling the supply of power to said blocking means from said power supply means to enable activation of said blocking means to prevent operation of said firearm." The structure disclosed in appellants' specification corresponding to the power control means includes "a biometric device such as a fingerprint reader."

The Examiner contends that a fingerprint reader "is not the same" as a finger print scanner. As previously explained, the Examiner is applying the wrong test. The Examiner has not explained why a "fingerprint reader" and a "finger-print scanner" are not "substantially the same" for the purposes of this invention. In fact, they are substantially the same. In both cases, the device compares the gun operator's fingerprint to a fingerprint stored in the microprocessor to determine if the operator is an authorized user, in which case the locking mechanism is unlocked. Precisely how the fingerprint is "scanned" or "read" is irrelevant to this invention.

The 35 U.S.C. § 102(e) Rejection

The Examiner's 35 U.S.C. § 102(e) rejection stands or falls with the Examiner's 35 U.S.C. § 135(b) rejection. If applicants are entitled to copy the claims of the '039 patent, then an interference should be declared and the 102(e) rejection withdrawn.

Finally, it bears emphasizing that applicants have unequivocally shown that the invention disclosed and claimed in the '039 patent originated from the applicants. No clearer case of theft of an invention could be shown. And no clearer case to justify the existence of the interference laws could be shown. The Examiner's reliance on 35 U.S.C. § 135(b) to deny applicants the opportunity to use the interference laws to

vindicate their rights amounts to little more than a technicality. The distinctions cited by the Examiner between the '039 claims and the applicants' earlier claims are trivial. Compounding the inequity of the situation is the fact that the Examiners did not locate the '039 patent and cite it as prior art until after the one year bar for claiming the same subject matter as an issued patent. That result was caused by the fact that the Patent and Trademark Office assigned the pending application to a different examining group than the group that had examined the '039 patent. Through no fault of their own, the applicants are the victims of circumstance. But the injustice of the situation can be easily remedied, fully consistent with 35 U.S.C. § 135(b), by reversing the outstanding rejections and declaring an interference.

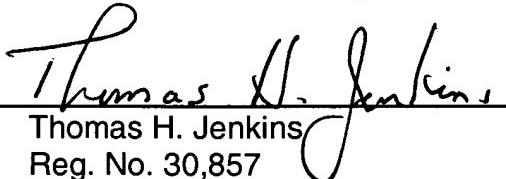
To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16, 1.17, or 41.20 that are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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